

App. Serial No. 10/865,695
Docket No.: DE 030200 US

Remarks

The non-final Office Action dated May 16, 2006 indicated that claims 1-6 and 9 stand rejected under 35 U.S.C. § 103(a) over Chari *et al.* (U.S. 4,428,046) in view of Dean (U.S. 4,641,375); and claim 7-8 are indicated as potentially allowable, if rewritten in independent form to include limitations of any intervening claims.

Applicant appreciates the suggestions in the Office Action regarding certain claim informalities. Applicant submits that the claims are proper as they particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Notwithstanding and in an effort to facilitate prosecution, Applicant has amended claims 1 and 9 to clarify certain aspects of the claimed limitations. Applicant requests that the objections to claims 1 and 9 be removed.

Regarding the indication of allowance of claims 7 and 8, Applicant appreciates the indication of allowability if rewritten in independent form. In view of the following arguments, Applicant submits that claims 7 and 8 should be in a condition for allowance because the claims that they depend from should be in a condition for allowance. Accordingly, Applicant requests that the objections of claims 7 and 8 be removed.

Applicant traverses the Section 103(a) rejections of claims 1-6 and 9, because the Office Action fails to provide correspondence for each and every claimed limitation. The Office Action fails to provide adequate evidence of motivation to suggest that the skilled artisan would modify the Chari reference with the teachings from the Dean reference, and the rejection is improper because the attempted modification of the Chari in view of the Dean would frustrate the purpose of the Chari reference. *See, e.g., In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

These traversing arguments, which are discussed further below, were previously presented, but the Office Action did not address Applicant's previous argument as required under MPEP 707.7(f), which states I pertinent part that the Examiner must "address any arguments presented by the applicant which are still relevant to any references being applied."

With regard to claims 1 and 9, Applicant submits that the Office Action continues to base the rejections on a mistaken assertion that the flag bits of Chari correspond to

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pilot signals. More specifically, the Office Action repeatedly refers to the flag bits as pilot signals. In doing so, the Office Action fails to address Applicant's previous arguments that such an assertion is unsupported and contrary to the plain meaning of the term pilot signal (as apparent from use of the term by the example references provided in Applicant's response dated October 28, 2005, which includes a reference previously used by the Examiner) as required by MPEP 707.7(f). Thus, the Office Action fails to show correspondence between the Chari reference and Applicant's claimed invention.

Applicant further submits that the Office Action does not provide adequate evidence of motivation to suggest that the skilled artisan would modify the Chari reference with teachings from the Dean reference. None of the cited portions of the asserted references support the proposed modification of the Chari reference. For instance, the Office Action's stated motivation is "to provide the star topology network of Chari with the improved ability to detect collisions resulting from a plurality of units..." However, the Office Action asserts that the Chari reference teaches handling of simultaneous arrival of flag bits, and thus, detects collisions resulting from a plurality of units. Accordingly, the proposed purpose of an "improved ability to detect collisions" would not be accomplished by the proposed modification. More specifically, the Office Action asserts that the Chari reference already teaches the ability to detect collisions and merely states that the proposed modification would be an improvement. The Office Action does not explain, and Applicant fails to see, how the references suggest that the modification would be an improvement.

Applicant further traverses the Section 103(a) rejection of claim 1 because such modification would undermine the purpose of the Chari reference. As consistent with relevant case law and the M.P.E.P., there is no motivation to modify a reference where the modification would undermine or defeat the purpose of the reference (*see, e.g., In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). An object of the Chari reference is to resolve contention among messages arriving from different subsystems (*see Col. 2, lines 24-39*). The Office Action attempts to modify Chari with the teachings of the Dean reference in such a manner as to use a pilot signal of varying frequency.

Applicant submits that this modification would render Chari inoperable for its stated purpose. For example, the Chari reference teaches a star coupler having circuitry

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for resolving contention among messages arriving at the star coupler (see Col. 2, lines 24-39). In contrast, the Dean reference teaches that collisions are detected via a RETURN fiber at each MAU (see Col. 2, lines 9-40). The RETURN fiber is taught to carry a signal representing sharing of received signals (see Col. 3, lines 22-25). The Office Action's assertion relies upon the Chari reference's teaching regarding contention circuitry 42. Applicant submits that were the flag bits to be replaced with the pilot signals of the Dean reference as proposed, the Chari decision circuit would fail to detect collisions. More specifically, the Dean reference teaches that collision detection is accomplished by each MAU monitoring the RETURN fibers rather than decoding flag bits using contention circuitry at the star coupler. Thus, the contention circuitry of the Chari reference is significantly different from the collision detection taught by the Dean reference, thereby rendering the proposed modification inoperable.

Moreover, the Dean reference teaches away from the Office Action's proposed modification. The Office Action appears to propose using the Chari reference's decision circuitry at the star coupler to detect collisions by monitoring pilot signals. Applicant submits that the Dean reference teaches that the collision detection circuitry is at each MAU. More specifically, the Dean reference teaches that each receiver has access to its own pilot source permitting synchronous demodulation of the returning pilot signal (see Col. 3, lines 11-15). Thus, the Dean reference teaches away from the detection circuitry of the Chari reference, which is located at the star coupler rather than at each MAU.

Without correspondence for each and every claimed limitation the rejections are improper. Accordingly, Applicant requests that the rejections of claims 1 and 9 be withdrawn.

With regard to claims 2-6, Applicant submits that claims 2-6 depend from claim 1, and thus, necessarily contain all the limitations of the claim from which they depend. In view of the aforementioned argument, claim 1 should be in a condition for allowance. Accordingly, Applicant requests that the rejections of claims 2-6 be withdrawn.

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In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney overseeing the application file, Adam L. Stroud, of Philips Corporation at (408) 474-9064.

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